UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,729	11/21/2000	Michael D. Ellis	UV/168	6773

1473 7590 02/02/2004

FISH & NEAVE
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK, NY 10020-1105

EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	5

DATE MAILED: 02/02/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/717,729	ELLIS, MICHAEL D.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-32 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 21 November 2000 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-32 of this application. In particular, the examiner cannot find adequate support for the limitation of "comparing the targeting criterion to stored user information".

Specification

2. The use of the trademark "WebTV" (Page 10, Line 30) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology if applicable. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "62" has been used to designate both the keyboard and monitor (Figure 4; Page 13, Lines 10, 28). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the reference sign "60" (Figure 4) not mentioned in the description. A proposed

drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 15-21, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Ballard (US Pat No. 6,128,050).

In consideration of claims 1 and 17, the Ballard reference discloses a system and method for providing a "targeted message" [54] to a plurality of users user that is used to "implement an interactive television application" such as an on-screen advertisement (Col 4, Lines 57-60). The method involves a "first processor" or advertising entity "creating a message" [54] having "associated targeting criteria" [58] which is subsequently "distributed . . . to a plurality of users". Upon receipt of the "message" the "second processor" or end-user computer "compares the targeting criterion to stored user information" [66/67] and upon satisfying the "targeting criterion" [58], the "message" [54] or advertisement is presented (Col 12, Line 30 – Col 13, Line 25).

Claims 2-4 and 18-20 are rejected wherein the "message" may be distributed via the "Internet" through a "television distribution facility" that supports internet services (ex. cable modem) (Col 4, Lines 57-60).

Claims 5 and 21 are rejected wherein the message is "presented" via a "set-top box" [14] (Col 5, Lines 25-28) in so far as it is operable to receive and process information received via a television network.

Claims 15, 16, 31, and 32 are rejected wherein the "message" [54] is provided via an "interactive television application provider" [52] that is distributed by or "provided from a television service provider" (Col 4, Lines 57-60).

7. Claims 1-5, 15-21, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al. (US Pat No. 6,177,931).

In consideration of claims 1 and 17, the Alexander et al. reference discloses a system and method for providing a "targeted message" such as an advertisement to a plurality of users user that is used to "implement an interactive television application" or electronic program guide (EPG) (Figure 1). The method involves a "first processor" such as an advertising distributor that "creates a message" or advertisement having "associated targeting criteria" in the form of selection intelligence criteria which is subsequently "distributed . . . to a plurality of users" (Col 34, Lines 10-25). Upon receipt of the "message" the user receiver, or "second processor", "compares the targeting criterion to stored user information" associated with the viewer profile which among other things describes/stores the user's interactions with the EPG and upon satisfying the "targeting criterion", the "message" or advertisement is presented (Col 32, Line 23 – Col 35, Line 37).

Claims 2-4 and 18-20 are rejected wherein the "message" or advertisements may be distributed via the "Internet" and/or via a "television distribution facility" (Col 34, Lines 10-25).

Claims 5, 6, 21, and 22 are rejected wherein the message is "presented" via a "set-top box" or via a "digital video recorder" (Col 3, Lines 1-7).

Claims 7 and 23 are rejected wherein the user is operable to "use the interactive television application to set a reminder based upon user input" (Col 9, Line 65 – Col 10, Line 29) and may further "compare the targeting criterion to stored user information relating to the reminder" in conjunction with the selection of an advertisement (Col 35, Lines 14-17).

Claims 11 and 27 are rejected wherein the user is operable to "use the interactive television application to select content for recording" (Col 10, Line 61 – Col 11, Line 7) and may further "compare the targeting criterion to stored user information relating to the content" in conjunction with the selection of an advertisement (Col 35, Lines 14-17).

In consideration of claims 14 and 30, the embodiment may further "compare the targeting criterion to stored user information that a television service provider has set" wherein the user receiver, which provides television service to the viewer, is operable to "set" or establish the viewer profile (Col 29, Lines 14-21). Alternatively, messaging may be based on "stored user information that a television service provider has set" in conjunction with terminal addressing information (Col 33, Lines 16-25).

Claims 15, 16, 31, and 32 are rejected wherein the "message" or advertisement may be provide via an "interactive television application provider" or from a "television service provider" (Col 34, Lines 10-15).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 10 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (US Pat No. 6,177,931).

In consideration of claims 10 and 26, as aforementioned, "stored user information" is subsequently compared to "targeting criterion" in order to determine or select an advertisement message to be presented to the user (Col 32, Lines 24-27). The Alexander et al. reference discloses that the "interactive television application" may be utilized to "set a parental control" (Col 17, Lies 12-36), however, it does not explicitly disclose nor preclude the use of such information in conjunction with targeting of advertisements. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize such EPG interactions as further criteria such as that associated with "parental control" for the purpose of using such information in order to better target advertisements of interest. For example, an indication that particular programs are restricted may be indicative of a user with children (Col 30, Lines 29-37) and as such the user may be interested in particular types of advertisments.

10. Claims 8, 9, 12, 13, 24, 25, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (US Pat No. 6,177,931) in view of Knee et al. (US Pat No. 5,589,892)

In consideration of claims 8 and 25, the Alexander et al. reference, as aforementioned, discloses an "interactive television application" or EPG wherein the embodiment further utilizes the viewer interactions and circumstances surrounding those actions (Col 28, Lines 30-32) to generate stored "user information". This "stored user information" is subsequently compared to "targeting criterion" in order to determine or select an advertisement message to be presented to the user (Col 32, Lines 24-27). The Alexander et al. reference, however, in disclosing EPG functionality does not disclose nor preclude that the embodiment may be further operable to perform a number of EPG functions known in the art. One such function that is not disclosed nor precluded in conjunction with the Alexander et al. EPG is that related to subscribing to services associated with premium content.

The Knee et al. reference explicitly discloses an EPG application the user may "use the interactive television application to subscribe to a service based upon user input" (Col 5, Lines 16-21; Figure 36C). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Alexander et al. embodiment to include EPG interactions such as those associated with the "subscribing to a service" such as that associated with premium services or other packaged programming for the purpose of advantageously providing a means by which the user may automatically purchase such programming (Knee et al.: Col 4, Lines 40-46). Furthermore, in light of the combined teachings, it would have been obvious to one having ordinary skill in the art at the time of the

invention to utilize such EPG interactions as further criteria for the selection of advertisements in order to better target advertisements of interest. For example, a user that subscribes to HBO® is more likely to be associated with a particular demographic and would therefore be interested in viewing advertisements targeted as such.

In consideration of claims 9 and 25, the Knee et al. reference discloses that the "interactive television application" may be utilized to "set a favorite setting" (Figures 8 and 37; Col 30, Lines 35-49). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Alexander et al. embodiment to include EPG interactions such as the designation of a "favorite setting" for the purpose of providing a means by which a user may customize the program guide and quickly navigate between channels of interest (Knee et al.: Col 27, Line 48 – Col 28, Line 5). Furthermore, in light of the combined teachings, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize such EPG interactions as further criteria for the selection of advertisements in order to better target advertisements of interest. For example, a user that designates ESPN as a favorite channel is likely to be interested in sport related advertisements.

In consideration of claims 12, 13, 28, and 29, the Knee et al. reference discloses that the "interactive television application" may be utilized to "order a product" or "order a service" (Col 36, Line 62 – Col 38, Line 31). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Alexander et al. embodiment to include EPG interactions such as those associated with the "ordering" of products and/or services for the purpose of utilizing the EPG as a new vehicle for marketing

program-related products and services capable of reaching a large audience including those who would not normally tune to existing home shopping channels (Knee et al.: Col 38, Lines 32-35). Furthermore, in light of the combined teachings, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize such EPG interactions as further criteria for the selection of advertisements in order to better target advertisements of interest.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Picco et al. reference discloses a system and method for inserting local content into programming content based on a comparison of the content criteria to locally stored user information/criteria.
- The Birdwell et al. (US Pat No. 6,108,706) reference discloses a broadcast system for the distribution of messages that are compared to targeting criterion in order to determine if the received information is displayed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB
January 21, 2004

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600